

REMARKS

This Response is submitted in reply to the Non-Final Office Action mailed on February 3, 2009. No fee is due in connection with this Response. The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 0112701-00691 on the account statement.

Claims 1-21 are pending in this application. In the Office Action, Claims 3 and 9 are objected to. Claims 1-2, 4-8, 10-12 and 15-21 are rejected under 35 U.S.C. §102. Claims 13 and 14 are rejected under 35 U.S.C. §103. In response, Claims 3 and 9 have been canceled without prejudice or disclaimer, and Claims 22-23 have been newly added. The claims do not add new matter. For at least the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 3 and 9 are objected to as being dependent upon a rejected base claim. The Patent Office asserts, however, that the Claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See, Office Action, page 4, lines 1-4. Accordingly, Applicants have newly added Claims 22-23, which contain the subject matter of originally filed and now canceled Claims 3 and 9, respectively. The new claims do not add new matter. The new claims are supported in the specification at, for example, pages 14-16. As such, Applicants respectfully submit that Claims 22 and 23 are in position for allowance.

In the Office Action, Claims 1, 2, 4, 11, 12 and 15 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,216,582 to Yoakim et al. ("*Yoakim*"). Claims 1, 2, 4-8, 10-12 and 15-21 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,897,899 to Fond ("*Fond*"). Applicants respectfully submit that both *Yoakim* and *Fond* are deficient with respect to the present claims.

Independent Claims 1 and 15 recite, in part, systems and methods, respectively, for selectively delivering different beverages having different foam levels by injection of a fluid under pressure into a capsule that contains a beverage-forming substance, comprising an extraction device and first and second capsules, the capsules being provided for selective use in the extraction device, with the first capsule having a first beverage dispensing structure so

constructed and arranged to retain a first extraction pressure in the capsule, prior to the complete delivery of the beverage, and the second capsule having a second beverage dispensing structure so constructed and arranged to retain a second extraction pressure in the capsule, prior to the complete delivery of the beverage, with the first extraction pressure being greater than the second extraction pressure. Thus, the presently claimed systems and methods are able to offer, within substantially the same format of capsule, beverages having different foam characteristics. Therefore, beverages of the same intrinsic nature but with different amounts of foam can be delivered such as coffees with crème or non-foamed coffees, foamed teas or non-foamed teas, while using a single machine and advantageously capsules of the same or substantially the same format. Therefore, it is possible to deliver beverages of very different foam characteristics depending upon the pressure controlled inside the capsules. See, specification, page 7, lines 1-15. In contrast, Applicants respectfully submit that *Yoakim* and *Fond* fail to disclose each and every element of the present claims.

Yoakim fails to disclose or suggest systems and methods for selectively delivering different beverages having different foam levels as required, in part, by independent Claims 1 and 15. Instead, *Yoakim* is entirely directed to a device for preparing a food product from capsules of different volumes. There is no indication that the combination of the device and capsules is ever adapted to deliver beverages of different foam levels. Indeed, at no place in the disclosure does *Yoakim* suggest that the device may derive beverages of different foam levels. *Yoakim* merely teaches the limited production of a concentrated drink in a cup of large capacity by using a single capsule instead of using typically two capsules of product in succession. See, *Yoakim*, col. 1, lines 29-36.

Yoakim also fails to disclose or suggest the first capsule having a first beverage dispensing structure so constructed and arranged to retain a first extraction pressure in the capsule, prior to the complete delivery of the beverage, and the second capsule having a second beverage dispensing structure so constructed and arranged to retain a second extraction pressure in the capsule as required, in part, by independent Claims 1 and 15. *Yoakim* contains no disclosure of any “dispensing structure so constructed and arranged” to retain extraction pressures in the capsule. The capsules of *Yoakim* only have a membrane 40 for closing the capsule, which is not a per se dispensing structure capable of retaining an extraction pressure by

itself that produces foam when the beverage is delivered from the capsules. In order to retain the extraction pressure in the food preparation device of *Yoakim*, the device must be designed with complementary means enabling cooperation with the capsules. Therefore, the capsules of *Yoakim* fail to disclose or suggest the presently claimed dispensing structures.

Further, the capsules of *Yoakim* do not include the dispensing structures, as discussed above, which would be designed to retain different pressures. *Yoakim* only teaches capsules of different dimensions (e.g., a single dose or a double dose). The first dimension contains a dose of substance to mix with the fluid to prepare a food product, while the capsule of the second dimension has between about 1.5 and about 3 doses. The relative volumes of the capsules of the first and second dimensions are preferably positioned to the dosage contained therein. See, *Yoakim*, page 2, lines 52-62.

Therefore, *Yoakim* only teaches different dimensions of capsules adapted to the dose of food product received therein. *Yoakim* is specifically directed toward providing one device that has a percolating head that is able to occupy different relative positions inside the percolating chamber according to the size of the capsule loaded into the device. See, *Yoakim*, Abstract. In fact, the Summary of the Invention and Detailed Description sections of *Yoakim* are replete with discussions of the advantages of being able to prepare food products from two different sized containers (i.e., a first container having first dimensions and a second container having second dimensions different from the first). See, for example, *Yoakim*, col. 1, lines 47-53; col. 2, lines 52-62, etc. It cannot be derived from *Yoakim* that different extraction pressures can be retained from the capsules when used in the device. Considering that the large-dose capsule would retain a different pressure of extraction from a single-dose capsule is not supported at any place in the disclosure of *Yoakim*. In fact, *Yoakim* teaches to vary the dimension of the capsule as a function of the dose required for preparing the beverage. In *Yoakim*, the variation of the dimension has no relation to the pressure of extraction. Furthermore, a person having ordinary skill in the art cannot derive any teaching on how the pressure of extraction would vary depending on the dimension of the capsules of *Yoakim*.

The Patent Office asserts that *Yoakim* discloses "first and second capsules 40, the capsules including a first and second beverage dispensing structure (varied amount of compacted beverage product within each capsule) to retain a first and second extraction pressure in the

capsule.” See, Office Action, page 2, lines 21-26. However, even if *Yoakim* discloses first and second capsules, at no place in the disclosure does *Yoakim* suggest that the first and second capsules have dispensing structures so constructed and arranged to retain extraction pressures in the capsule. See, *Yoakim*, col. 6, lines 41-59. In contrast, the present invention proposes systems and methods comprising an extraction device and capsules that are designed to make beverages with different foam levels using first and second capsules. For at least the above-mentioned reasons, *Yoakim* fails to disclose or suggest each and every element of the present claims.

Fond also fails to disclose or suggest the first capsule having a first beverage dispensing structure so constructed and arranged to retain a first extraction pressure in the capsule, prior to the complete delivery of the beverage, and the second capsule having a second beverage dispensing structure so constructed and arranged to retain a second extraction pressure in the capsule as required, in part, by independent Claims 1 and 15. Instead, *Fond* is entirely directed toward providing a sealed cartridge that has a base and a cover sealed to a lip of the base to cover the opening. The cover or the base provides a tear face that is torn under stress during extraction under pressure for preparing a beverage. See, *Fond*, Abstract. Accordingly, *Fond* discloses providing one cartridge that may have different characteristics.

Further, the capsules of *Fond* comprise merely a cover of monolayer 4 or multilayer (4a, 4b), which is not a beverage dispensing structure. A beverage dispensing structure should be capable of retaining a pressure of extraction upon injection of fluid under pressure in the capsule. In order for the capsule to dispense a beverage, the cover of the capsule must be associated with a plate with projecting members of the capsule holder that tears off the cover when a sufficient pressure is attained in the capsule. Therefore, the capsules of *Fond* do not include their own beverage dispensing structures constructed and arranged in the capsules to retain the beverage pressure. The capsules of *Fond* are also not capable of producing different foam levels.

Additionally, there is no indication at any place in the disclosure of *Fond* that the capsules of Figures 1 and 2 are capable of retaining different pressures of extraction prior to the complete delivery of the beverage. Even if the capsules of Figures 1 and 2 would theoretically provide different extraction pressures, the capsules are not part of a system designed for providing beverages by producing different foam levels. For at least the above-mentioned reasons, *Fond* fails to disclose or suggest each and every element of the present claims.

Moreover, anticipation is a factual determination that “requires the presence in a single prior art disclosure of each and every element of a claimed invention.” *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis added). Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. See, e.g., *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). As such, a reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found. Because *Yoakim* and *Fond* fail to disclose each and every element of the present claims, *Yoakim* and *Fond* fail to anticipate the present claims.

Accordingly, Applicants respectfully submit that the anticipation rejections of Claims 1-2, 4-8, 10-12 and 15-21 over *Yoakim* and *Fond* be reconsidered and withdrawn.

In the Office Action, Claims 13 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Fond* in view of *Yoakim*. Applicants respectfully submit that the patentability of independent Claim 1 as previously discussed renders moot the obviousness rejection of Claims 13-14 that depend from Claim 1. In this regard, the cited art fails to teach or suggest the elements of Claims 13-14 in combination with the novel elements of Claim 1.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

K&L GATES LLP

BY 

Robert M. Barrett
Reg. No. 30,142
Customer No. 29157
Phone No. 312-807-4202

Dated: April 21, 2009